UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,875	08/31/2001	Eric Elwood Gentry	10019418-1	2230

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EXAMINER
NGUYEN, VAN H

ART UNIT	PAPER NUMBER
2194	

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/943,875	GENTRY ET AL.
	Examiner	Art Unit	
	VAN H. NGUYEN	2194	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 December 2005*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *35-42* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *35-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

WILLIAM THOMSON
SUPERVISORY PATENT EXAMINER

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This Office Action is in response to the amendment filed December 19, 2005.

Claims 35-42 are pending in this application. Claims 1-34 have been cancelled.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

3.   Claims 36 and 40-42 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

4.   Pages 10-11 of Applicant's specification provide guidance as to what Applicant

considers to fall within the scope of the phrase "computer-readable medium" as used in

currently pending claims 36 and 40-42. The pertinent portion of pages 10-11 are as

follows:

> In the context of this document, a "computer-readable medium" can be
> any means that can contain, store, communicate, propagate, or transport
> the program for use by or in connection with the instruction execution
> system, apparatus, or device. The computer readable medium can be,
> for example but not limited to, an electronic, magnetic, optical,
> electromagnetic, infrared, or semiconductor system, apparatus, device,
> or propagation medium. More specific examples (a nonexhaustive list)
> of the computer-readable medium would include the following: an
> electrical connection (electronic) having one or more wires, a portable
> computer diskette (magnetic), a random access memory (RAM)
> (electronic), a read-only memory (ROM) (electronic), an erasable
> programmable read-only memory (EPROM or Flash memory)
> (electronic), an optical fiber (optical), and a portable compact disc read-
> only memory (CDROM) (optical). Note that the computer-readable
> medium could even be paper or another suitable medium upon which
> the program is printed, as the program can be electronically captured,
> via for instance optical scanning of the paper or other medium, then

> compiled, interpreted or otherwise processed in a suitable manner if
> necessary, and then stored in a computer memory.

5.   Thus it is clear that while Applicant has not provided an explicit and deliberate

definition limiting the phrase "computer-readable medium," Applicant has provided an

explicit and deliberate definition of items Applicant intends to fall within the scope of

"computer-readable medium." Within this list of items are types of media which would

have been recognized by one of ordinary skill at the time of the invention as storage

media, propagation or transmission media, and printed matter. It is believed that the

types of storage media listed by Applicant would have enabled the recited program logic,

when stored thereon, to be read and executed by a computer and realize its functionality.

It is not believed, however, that the recited propagation or transmission media would

likewise enable the functionality to be realized. Absent recitation of some means for

receiving and processing the program, propagation or transmission media are not

believed to be, in and of themselves, capable of providing the program in a manner which

enables it to be read and executed by a computer, with subsequent realization of its

functionality to accomplish a practical application by causing the computer to perform

operations with a useful, concrete and tangible result.

6.   Certainly, Applicant's inclusion of a piece of paper with the program printed

thereon within the scope of "computer-readable medium" indicates the claims are

sufficiently broad to read on non-functional descriptive material, printed matter. Printed

matter which fails to be functionally interrelated to its substrate has long been held to be

nonstatutory.

From MPEP 706.03(a):

> For example, a mere arrangement of printed matter, though seemingly a
> "manufacture," is rejected as not being within the statutory classes. See
> In re Miller, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969); Ex parte
> Gwinn, 112 USPQ 439 (Bd. App. 1955); and In re Jones, 373 F.2d
> 1007, 153 USPQ 77 (CCPA 1967).

7.   As such, claims 36 and 40-42 are not limited to embodiments which would enable

execution of the program by a computer to realize its functionality and provide a practical

application with a useful, concrete and tangible result. Note that any deletions from the

specification may raise a question with respect to New Matter.

Claim Rejections - 35 USC § 103

8.   The text of those sections of Title 35, U.S. Code not included in this action can be

found in a prior Office action.

9.   Claims 35-37 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable

over **Fleming, III** in view of **Momose** and further in view of **Udelstein et al.**

10.   As to claim 35, Fleming teaches a method *(see the Abstract)* for installing a driver

(e.g., installs device driver software) for a hardware device *(e.g. ,a device)* on a

computer *(e.g., a computer system)*, the method comprising:

        determining if the hardware device is connected to the computer *(e.g., a detection*

mechanism that detects the presence of a device in a computer system; see the Abstract;

col.2, lines 1-15, 21-24; and col.4, lines 54-64); and

if it is determined that the device is connected to the computer, then installing

the driver provided with the hardware device *(e.g., installs the current driver on the*

computer system; abstract; col.5, lines 25-33; and fig. 3).

The detection mechanism of Fleming, however, is silent on "if it is determined

that the device is not connected to the computer, then instructing a user to connect the

hardware device to the computer."

Momose teaches if it is determined that the device is not connected to the

computer, then instructing a user to connect the hardware device to the computer *(e.g.,*

see fig.11 and the warning dialogue box discussion beginning at col.10, line 13).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to combine the teachings of Momose with Fleming because

Momose's teachings would have notified the user when the device is not connected to the

computer system, and prompted the user to connect the device to the computer system.

The combination of Fleming and Momose, however, does not specifically teach

determining if an operating system on the computer includes a Windows installer service;

if it is determined that the operating system does not include a Windows installer service,

then removing any driver for the device provided by the operating system and setting up

the operating system to use a driver provided with the device; if it is determined that the

operating system includes a Windows installer service, then updating any driver for the

device associated with the Windows installer service with a driver provided with the

device.

Udelstein teaches determining if an operating system *(e.g., the operating system)*

on the computer *(e.g., the target computer system)* includes a Windows installer service

(e.g., a WINDOWS INSTALLER program module); if it is determined that the operating

system does not include a Windows installer service *(e.g., operable to detect)*, then

removing any driver for the device provided by the operating system and setting up the

operating system to use a driver provided with the device *(e.g., dynamically creating or*

modifying an install-set); if it is determined that the operating system includes a

Windows installer service, then updating any driver for the device associated with the

Windows installer service with a driver provided with the device *(e.g., The installation*

program module 137 is operable to determine which of the components 136a-g are to be

included in the install-set, i.e., the set of components that are to be installed onto target

computer system 120. The install-set typically includes all required components and any

optional components that are determined by the installation program module 137 to be

appropriate for installation onto the target computer system 120) [see col.6, line 24-

col.7, line 15].

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to combine the teachings of Udelstein with Fleming as modified by

Momose because Udelstein's teaching would have provided the capability for

dynamically creating and modifying an install-set, without user interaction, to

accommodate the needs of an individual user and/or the requirements of an individual

computer system.

11.   As to claim 37, Fleming teaches acquiring the driver provided with the hardware

device from a network source *(e.g., the driver retrieving mechanism is configured to send*

an identifier for the computer system to the remote host so that the remote host can return

a version of the current driver that is tailored to the computer system; col. 2, lines 43-

47/the system retrieves current driver 116 from server 112 across net work 111; col. 5,

lines 14-24 and fig. 3).

12.   As to claims 36 and 40, note the rejection of claims 35 and 37 respectively.

Claims 36 and 40 are the same as claims 35 and 37, except claims 36 and 40 are

computer readable medium claims and claims 35 and 37 are method claims.

13.   Claims 38, 39, 41, and 42 are rejected under 35 U.S.C. 103(a) as being

unpatentable over **Fleming** in view of **Momose** and **Udelstein et al.** as applied to claims

35 and 36 above and further in view of **Nykanen et al.**

14.   As to claim 38, the combination as applied to claim 35 above does not specifically

teach determining which of a plurality of hardware device instances connected to the

computer system are to be removed from the computer system; and removing from a

device object the hardware device instances determined to be removed from the computer

system.

Nykanen teaches determining which of a plurality of hardware device instances

connected to the computer system are to be removed from the computer system; and

removing from a device object the hardware device instances determined to be removed

from the computer system *(e.g., see the removing of devices discussion, beginning at*

col.7, line 39. See also figs. 5a-5c).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to apply the teaching of Nykanen to the combined references above

because Nykanen's teaching would have provided the capability for detecting and

identifying the devices connected to the computer system, and removing the unused

devices in the computer system. Therefore, facilitating the installation of the driver on

the computer system.

15.   As to claim 39, the combination as applied to claim 35 above does not specifically

teach removing any shortcut for the hardware device instances that are determined to be

removed from the computer system.

Nykanen teaches removing any shortcut for the hardware device instances that are

determined to be removed from the computer system *(e.g., see the removing of icon*

discussion, beginning at col.7, line 30).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to apply the teaching of Nykanen to the combined references above

because Nykanen's teaching would have provided the capability for removing an icon

associated with an inactivated device in a computer system.

16.   As to claims 41 and 42, note the rejection of claims 38 and 39, respectively.

Claims 41 and 42 are the same as claims 38 and 39, except claims 41 and 42 are

computer readable medium claims and claims 38 and 39 are method claims.

Response to Applicant's Arguments

17.   Applicant argues that the claims are statutory because they are directed to a

computer readable medium and that, "computer readable medium is statutory subject

matter. This broad-based conclusion lacks support in the court cases cited. A computer

readable medium carrying instructions which when executed impart functionality to a computer to cause the computer to perform a practical application with a useful, concrete and tangible result is statutory subject matter.

In this instance, when read in light of Applicant's specification, the claims cover some embodiments where the computer readable medium carries instructions in an executable manner so as to cause such functionality to occur, and they cover nothing more than a piece of paper. Contrary to Applicant's erroneous assertion, the examiner is not reading limitations into the claims from the specification. The examiner is in no way indicating that the computer readable medium is limited solely to the specifically mentioned examples in Applicant's specification. Any equivalents thereto would be established by what is known to those of ordinary skill in the art. Instead, the examiner is basing the rejection on the indisputable fact that Applicant's specification provides clear evidence that Applicant intends for the computer readable medium claims to cover a piece of paper. As indicated in the rejection itself, the courts have long held that a mere arrangement of printed matter, though seemingly a "manufacture," is not patent-eligible. As such, Applicant's arguments are not persuasive. Applicant is again reminded that any changes to the original disclosure, including deletions from the specification, would raise the issue of New Matter.

18.   Applicant argues that Edelstein does not make any determination that the operating system does or does not include a Windows installer... Edelstein doesn't have anything to do with device drivers. Contrary to Applicant's contention, Udelstein teaches determining if an operating system *(e.g., the operating system)* on the computer *(e.g., the target computer system)* includes a Windows installer service *(e.g., a*

WINDOWS INSTALLER program module); if it is determined that the operating system

does not include a Windows installer service *(e.g., operable to detect)*, then removing any

driver for the device provided by the operating system and setting up the operating

system to use a driver provided with the device *(e.g., dynamically creating or modifying*

an install-set); if it is determined that the operating system includes a Windows installer

service, then updating any driver for the device associated with the·Windows installer

service with a driver provided with the device *(e.g., The installation program module 137*

is operable to determine which of the components 136a-g are to be included in the

install-set, i.e., the set of components that are to be installed onto target computer system

120. The install-set typically includes all required components and any optional

components that are determined by the installation program module 137 to be

appropriate for installation onto the target computer system 120) [see col.6, line 24-

col.7, line 15].

19.   Applicant's arguments have been fully considered but are deemed to be

unpersuasive. For the reasons detailed above, the rejections are maintained as set forth

supra.

Conclusion

20.   The prior art made of record, see PTO 892, and not relied upon is considered

pertinent to applicant's disclosure. Applicant should review these references carefully

before responding to this office action.

21.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of

time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

advisory action. In no event, however, will the statutory period for reply expire later than

SIX MONTHS from the mailing date of this final action.

Contact Information

22.   Any inquiry or a general nature or relating to the status of this application should

be directed to the TC 2100 Group receptionist: (571) 272-2100.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to VAN H. NGUYEN whose telephone number is (571)

272-3765.

The examiner can normally be reached on Monday-Thursday from 8:30AM

6:00PM. The examiner can also be reached on alternative Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, WILLIAM THOMSON can be reached at (571) 272-3718.

The fax phone number for the organization where this application or

proceeding is assigned is **(571) 273-8300.**

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:
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Van H. Nguyen

WILLIAM THOMSON
SUPERVISORY PATENT EXAMINER